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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,540	12/11/2001	Nicholas Ling	690068.405C3	4186

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EXAMINER

BORIN, MICHAEL L

ART UNIT	PAPER NUMBER
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1631

9

DATE MAILED: 08/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/015,540

Applicant(s)

LING ET AL.

Examiner

Michael Borin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-34,45,46,48-50,73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 30-34,45,46,48-50,73 and 74 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Amendment (PTO-893) Paper No(s) \_\_\_\_
- 3) ☐ Information Sheet on Continued Examination (PTO-894) Paper No(s) \_\_\_\_

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### Part III DETAILED ACTION

Claims 30-34,45,46,48-50, 73,74 are pending.

It is noticed that SEQ ID No. 3 does not correspond to fragment 86-99 of SEQ ID No. 2; it seems that rather, it is fragment 70-85 of SEQ ID No. 2.

Further, applicant is requested to provide SEQ ID number on Fig. 1.

#### Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 30-34,73,74 drawn to peptides comprising consecutive residues of SEQ ID No. 3, classified in class 530, subclass 329.
- II. Claims 45,46,48-50,74 drawn to peptides comprising non-consecutive residues of SEQ ID No. 3, classified in class 530, subclass 329.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and II are drawn to independent and/or patentably distinct peptides since each would be expected to possess distinctly different structure, and/or physico-chemical properties, and/or capable of separate manufacture and/or use. The products of Group II are drawn to peptides comprising non-consecutive residues of SEQ ID No. 3, whereas products of Group I are drawn to peptides comprising consecutive residues of SEQ ID No. 3. Accordingly, a reference teaching a scrambled sequence of Group II will not teach or suggest a peptide of Group I. The Groups will require non co-extensive literature and sequence searches.

Because these inventions are distinct for the reasons given above and the

Applicant is advised that the response to this requirement must be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

### **Election of Species Requirement**

Election of species should be required prior to a search on the merits in all applications containing both species claims and generic or Markush claims.(MPEP 808.01(a))

Upon election of any single one of the Groups from above the following election of species is hereby required for the initial search for examination on merits:

The claims of Group are individually or dependently directed to a plurality of disclose patentably distinct species of peptides having various replacements of Lys-91 (as specified in claims 33,34,49,50, which will require a burdensome separate bibliographic, manual and computer search. Accordingly, regardless of which group is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (i.e., a single compound), even though the requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

To be complete, a response to the election of species requirement should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. MPEP 809.02(a).

The examiner should be directed to Michael Borin whose telephone number is +703 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by

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telephone are unsuccessful, the examiner's supervisor Mr. Michael Woodward, can be reached at (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

8/5/03  
mlb

MICHAEL BORIN, PH.D  
PRIMARY EXAMINER

